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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,559	02/06/2004	Hiromichi Kobayashi	1217-040223	3556

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,559

Applicant(s)

KOBAYASHI ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-15,32-38 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-31 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15,32-38 and 51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This is in response to Papers filed on 01 June 2007.

I. In view of the terminal disclaimer and amendments of independent claims 16 and 17 filed on 01 June 2007, the rejections on the record have been overcome and withdrawn. New searches are made in accordance with the amended embodiments. Some new references are newly found and applied.

II. There has been on the record in the Office action mailed on 29 January 2007 that:

“Applicants’ elect the invention of Group III, claims 16-31 and 39-50 without traverse on 18 December 2006 being acknowledged. There are two groups of claims (16 and 20-31) and (17-19 and 39-50). The record shows that they are not considered to be patentably distinct. Therefore, no restriction in between them is made. Accordingly, no separate consideration or search will be made. However, applicants should disagree, urge, show provide an evidence to the contrary for the record in the next response to this Office action in order for it to be considered timely. The evidence as urged and/or admission as stated on or for the record will

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be used to made a restriction in between two group of the claims in the next Office action.”

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lambert (6,232,026).

Lambert discloses, teaches and suggests a resin coated carrier core. The core comprises more than two groups of metal oxides, especially with one or more of metal oxide groups of TiO_2 , ZrO_2 and Ta_2O_5 as newly amended by applicants on 01 June 2007. Please see the whole disclosure of the applied reference, especially at least col.5:31-45, 8:53 to 9:22, Examples 1-4, 9-12 and 33-36. The language “melting point of not higher than 1000°C ” “melting point of not lower than 1800°C ” or “electrical resistivity...” or the like is a functional property or a measurement of a functional property of a material and considered inherent. For a patentability of a functionally claimed property embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to

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the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about the same functionally claimed property embodiment as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be rendered *prima facie* obvious by Lambert.

IV. The above applied reference is new. Accordingly, the arguments filed on 29 May 2007 have been considered but have little value with respect to the newly applied references. The showings in the specification have been considered but is not close to those of the applied embodiments of the reference and have little value as compared the broadly claimed embodiments.

V. Thompson et al (6,571,077) and Lambert et al 6,723,481 have the same or about the same teachings and suggestions as that in the above applied references and are cumulative but may be later applied when an amendment is made.

VI. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

VII. After the Final Office action, applicants are still requested and required to provide an evidence to the contrary for each of the functionally claimed embodiments in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429 as clearly pointed out set forth on record in order for an authority

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committee to wisely and correctly make a decision based on a provided evidence in a appeal process.

VIII Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
19 June 2007

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le